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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,563	05/16/2001	Yukio Kinoshita	503.40130X00	1509
20457	7590	11/04/2004	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			PONOMARENKO, NICHOLAS	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,563

Applicant(s)

KINOSHITA, YUKIO

Examiner

Nicholas Ponomarenko

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE dated 6/14/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 11 and 18 are incomprehensible, because such claimed elements as "device" motor", "machine", "generator" described in such manner that one of ordinary skill in the art would be confused what is what and what drives what and how?

Claims 2-17 and 19 are indefinite because they depend on the rejected claim and do not correct the noted problem.

4. Following proposed draft for claims 11 and 18 would overcome rejection under 35 U.S.C. 112, second paragraph:

Claim 11. (Amended) A system for generating or utilizing an electrical power, comprising:

an electrical device with a means for providing capability to said electrical device to function as a motor or as a generator;

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a source of mechanical power to drive said electrical device as a generator;

a source of electrical power to drive said electrical device as a motor and utilize said motor to drive a machine;

wherein, said electrical device is interfaced with an electrical network with a plurality of sensors and controls for changing its operational status from a motor to a generator or vice-versa based on the predetermined conditions.

18. (Amended) A system for generating or utilizing and electrical power, comprising:

an electrical device with a means for providing capability to said electrical device to function as a motor or as a generator;

a source of mechanical power to drive said electrical device as a generator;

a first source of electrical power to drive said electrical device as a motor and utilize said motor to drive a machine;

a second source of electrical power to drive said electrical device as a motor and utilize said motor to drive a machine;

wherein, said electrical device is interfaced with an electrical network with a plurality of sensors and controls for changing its operational status from a motor to a generator or vice-versa based on the predetermined conditions.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. As far as they can be understood, Claims 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura (US 4,951,769) as applied to claims 11 and 18, and further in view of common knowledge in the art.

Kawamura teaches a system with an electrical device, which can function as a motor or as a generator with a source of mechanical power to drive said generator for generating of an electrical power, and with a source of an electrical power for driving said electrical device as a motor and use this motor to drive a machine, essentially as claimed in claims 11 or 18.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a system as taught by Kawamura and to design its application for needs in order to have a system per specification requirements, especially since applicant(s) failed to show that their system differs from any commonly known system or has capabilities different from the achievable in a common design.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant(s) disclosure.
8. When the claims are amended, applicant(s) should state in detail where in the original disclosure or in the drawings the amended features find support. **No new matter may be introduced.**
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Ponomarenko whose telephone number is (571) 272- 2033, Fax: (571) 273-2033, or to his SPE Darren Schuberg – (571) 272-2044.
10. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2800 Customer Service
Phone: (571) 272-2815

np
October 28, 2004



Nicholas Ponomarenko
Primary Examiner
Technology Center 2800